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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,771	03/07/2006	Olivier Besnard	0540-1038	5725

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YOUNG & THOMPSON  
745 SOUTH 23RD STREET  
2ND FLOOR  
ARLINGTON, VA 22202

EXAMINER

AUDET, MAURY A

ART UNIT	PAPER NUMBER
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1654

MAIL DATE	DELIVERY MODE
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07/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/551,771

Applicant(s)

BESNARD ET AL.

Examiner

Maury Audet

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-7 and 9-21 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The present application has been transferred from former Examiner Young to the present Examiner. Based on claims, as well as amendments thereto, restriction is necessitated and proper (see MPEP 801, regarding restriction as necessary irrespective of the stage of prosecution/examination).

#### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept.

In accordance with 37 CFR 1.142, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-7 and 9-14, drawn to product/composition comprising any wetting agent or any penetrating agent used in agriculture, an "any homopolymeric, spiral, oligopeptide"; classified in class 514, subclass 2+.
- II. Claim 15-21, drawn to a method for treating "any plant" comprising comprising a wetting agent or a penetrating agent used in agriculture, at least one homopolymeric, spiral, oligopeptide; classified in class 424, subclass 1.69+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

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product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product, namely any homopolymeric, spiral oligopeptide, beyond even the two distinct peptides in e.g. claim 14.

The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference, which would anticipate the invention of one group, would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all of the above inventions in one application. Restriction for examination purposes is therefore proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not necessarily required for Group II, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

***Requirement for a Single Oligopeptide Election as the Invention of Either Group I or II***

Any oligopeptide is a distinct compound, absent evidence to the contrary that a search of any oligopeptide and finding thereof, will also render any other oligopeptide an obvious variation. Absent such in writing, Applicant must identify a substantial, distinguishable, assertedly novel (otherwise the search once again turns on an individual peptide basis), core structure that runs through the oligopeptides, to allow for a coextensive search of more than one distinct oligopeptide (assumedly which imputes the same function upon ALL plants (as broadly claimed)). Absent such a showing in writing of such a structure and function in ALL plants, each oligopeptide is a distinct compounds which must be individually searched and examined upon it's own merits. Therefore, irrespective of whether Group I or II is elected as the invention, Applicant must elect a single oligopeptide as the invention, to which the elected Invention group will be searched. Alternatively, the Examiner is willing to search and examiner both of the distinct oligopeptides of claim 14, should Applicant so elect these two distinct peptide, as the invention. **This requirement is not to be taken as an election of species, but rather as an election of a single invention, since each compound is assumed to be a patentably distinct invention, in the absence of evidence to the contrary.**

***Requirement for a Single Plant Election as to Group II Invention***

As described above, the invention contains distinct oligopeptides peptides. Additionally, Applicant is claiming that ANY spiral, homopolymeric oligopeptide will work to treat ANY plant against pathogens. This Examiner finds this proposition somewhat unrealistic, as it is well known in the agricultural arts even that certain pesticides do not even work on all plants to treat

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all pathogens. Furthermore, and as relevant at this stage of examination, a search of ANY plant to see if ANY oligopeptide has been used thereon to treat in a fashion targeting ANY pathogen is grossly burdensome. Thus, if Group II is elected, Applicant must also elect a single plant (e.g. cereal, fruit, grape, lawn, horticulture plant, oil producing plant, soy, sunflower, melon, carrot, cauliflower, potato) as the plant of the invention, to which the single oligopeptide will be searched thereto. Absent an indication that any art found on said oligopeptide used on any plant for the stated purpose, will also render such use on any other plant an obvious variation therefrom. **This requirement is not to be taken as an election of species, but rather as an election of a single invention, since each compound is assumed to be a patentably distinct invention, in the absence of evidence to the contrary.**

***Requirement for a Single Plant Election as to Group II Invention***

As described above, the invention contains distinct oligopeptides peptides, distinct plants, and finally distinct pathogens to which are the ultimate treatment target of said oligopeptides applied to said distinct plant. Like the plant analysis, absent evidence to the contrary that ANY distinct oligopeptide applied to ANY distinct plant is capable of treating ANY distinct pathogen thereon, and any art found thereto will also render any other pathogen treated as obvious thereto – Applicant must elect a single pathogen relevant to the single elected plant. A search of ANY plant and ANY potential pathogen that may infect ANY said plant being wholly burdensome. **This requirement is not to be taken as an election of species, but rather as an election of a single invention, since each compound is assumed to be a patentably distinct invention, in the absence of evidence to the contrary.**

***Species Election***

This application contains claims directed to the following patentably distinct species of the claimed invention:

1. A single wetting agent used in agriculture; or
2. A single penetrating agent used in agriculture; and

The species are independent or distinct because a search for any of the above species is not necessarily co-extensive particularly with regard to the literature search and a reference, which would anticipate any one of the above species, would not necessarily anticipate or even make obvious another species, absent evidence to the contrary.

Applicant is required under 35 U.S.C. section 121 to elect a single disclosed species above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claim 1, 14, and 15 are generic.

Applicant is advised that a reply to this requirement must include an identification of the elected species consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, Applicant must indicate which are readable upon the elected species. MPEP section 809.02(a).

Should Applicant traverse on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species

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to be obvious variants or clearly admit on the record that this is the case. In either instance, if Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. section 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***In re Ochiai/Brouwer Rejoinder***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.



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***Conclusion***

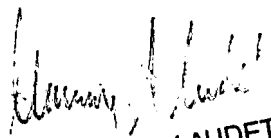
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached on M-Th. 7AM-5:30PM (10 Hrs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA, 7/21/2007

  
MAURY AUDET  
PATENT EXAMINER